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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/488,037 01/19/00 WINTER A HOE-92/F-253

HM22/0607
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EXAMINER

NAZARIO GONZALEZ, P

ART UNIT

PAPER NUMBER

1621

DATE MAILED:

06/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/488,037

Applicant(s)
Winter et al.

Examiner
Porfirio Nazario-Gonzalez

Group Art Unit
1621



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/107,187.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/107,187, filed on August 16, 1993.

Interference Estoppel

2. Claims 1-3 are rejected on the basis of interference estoppel under 37 CFR § 1.658(c). The present claims require bridged metallocenes wherein the variables R_1 and R_2 in the bridging group are different (in which "two or more of the radicals R^3 to R^6 , together with the atoms connecting them, form a ring system,"), The count of Interference 104,447 included bridged metallocenes wherein the variables R_1 and R_2 in the bridging group are either different or the same. The interference file does not reveal that applicants filed a preliminary motion under 37 CFR § 1.633(c)(1) to substitute a count limited to the variables R_1 and R_2 being the same. At the time the interference was declared, a presumption attached that the claims of the Winter patent are directed to a single patentable invention. 37 CFR § 1.606, next-to-last sentence. The presumption is overcome through a preliminary motion under 37 CFR § 1.633(c)(1) to, in effect, narrow the count. Since applicants did not file the necessary preliminary motion during the interference, Karl had every reason to rely on the preliminary motion and did not have an

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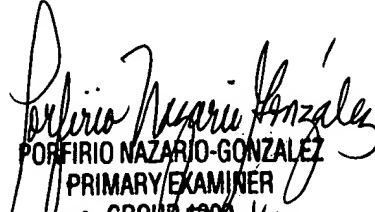
opportunity to challenge the position currently being taken by applicants. Applicants are estopped under 37 CFR § 1.658© from taking an action ex parte which they failed to take during the interference. Since applicants filed no preliminary motion during the interference to place in issue inter partes the separate patentability of the variables R_1 and R_2 being the same versus the variables R_1 and R_2 being different, they are now estopped to do so ex parte in this application.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Nazario-Gonzalez whose telephone number is (703) 308-4632. The Examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

PNG
June 2, 2000


PORFIRIO NAZARIO-GONZALEZ
PRIMARY EXAMINER
GROUP 1260-1600
He